

## **REMARKS**

Claims 1-32 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Applicant would like to thank the Examiner for courtesy extended during the personal interview conducted on November 10, 2005. During the interview, Applicant's attorney, the Examiner, and Primary Examiner Paul Rodriguez discussed Applicant's claims in view of the cited art. The Examiners agreed that Applicant's claim distinguish over Furukawa (U.S. Pat. No. 6,498,998) and Meyer (U.S. Pat. No. 6,076,180).

The Examiner objected to the Abstract. A replacement Abstract is being submitted herewith.

The Examiner objected to Claims 7, 22 and 29-32 for various reasons. The spelling error in Claim 7 was corrected. Claim 22 now depends from Claim 21. The preamble of Claims 29-32 was corrected. The amendments are not narrowing amendments. Therefore, these objections are now moot.

## **SPECIFICATION**

The specification stands objected to for certain informalities. Applicant have amended Claims 15, 20, and 24 to more clearly define Applicant's invention. The amendments are not narrowing amendments. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 15, 20 and 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Applicant has amended Claim 15 to recite “wherein the output of the means for adding is received by the second means for reading data.” Applicant has amended Claims 20 and 24 analogously. Applicant respectfully submits that Claims 15, 20, and 24 are now definite. The amendments to the claims are not narrowing amendments.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 24-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Furukawa (U.S. Pat. No. 6,498,998). This rejection is respectfully traversed.

To sustain a rejection under 35 U.S.C. §102(e), the Examiner must show that a reference shows each element of a claim and its relationship to other elements of a claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil co. of California, USPQ2d 1051, 1053 (Fed. Cir. 1987). Not only must the reference show each and every element of the claim, the elements must be arranged as set forth in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 (Fed. Circ. 1989).

Applicant’s invention is directed to testing a system on a chip (SOC). More specifically, Applicant’s invention is directed to “testing a first system on a chip (SOC), with a second SOC)” as recited in Claim 24. In contrast, Furukawa relates to a

semiconductor testing apparatus, and more particularly to an apparatus for testing an A-D converting unit. Furukawa does not show, teach, or suggest a first SOC or a second SOC, and therefore does not show, teach, or suggest a method of testing a first SOC with a second SOC.

More particularly, Furakawa '998 as best understood discloses the use of two waveform generators 21 and 22. The first waveform generator 21 generates a test waveform 50 and an expectation value, which is output to the comparator 16. The second waveform generator 22 generates a timing output 54. The waveform synthesizing unit 28, which may be an adder, adds the timing output 54 and the test waveform 50 and outputs the combined waveform to the A/D converting device 90, which is the chip under test. None of the remaining structures are described as integrated circuits or SOC's.

For at least the foregoing reasons, Applicant believes that Claim 24 is allowable over the prior art of record. Claims 25-28 are directly or indirectly dependent upon Claim 24 and are therefore allowable for at least similar reasons.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 4-6, 9-11, 14, 16, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer (U.S. Pat. No. 6,076,180) in view of Furukawa (U.S. Pat. No. 6,498,998).

With respect to Claim 1, Meyer fails to show, teach or suggest first and second SOC's as recited.

As best understood by Applicant, Meyer relates to a test bench that is simulated in a computer system via software such as very high definition language. As defined in Meyer,

the term "module" refers to software code which defines one or more functions, procedures and/or devices. The term "IDE controller module" refers to software code that simulates the operations and characteristics of a desired IDE controller model.

See Meyer at Col. 3, lines 6-25. Therefore, both IDE controller modules 301 and 303 appear to be implemented by the same system and not first and second SOC's as recited.

As set forth above, Furakawa '998 fails to show, teach or suggest the claimed structure in Claim 1 since it too fails to show, teach or suggest first and second SOC's as recited. Claim 1 is allowable over the prior art for at least the foregoing reasons. Claims 2-5 are directly or indirectly dependent upon Claim 1 and are allowable for at least similar reasons.

Claims 6, 11, 16, and 21 are allowable over the prior art for at least similar reasons as Claim 1. Claims 7-10, 12-15, 17-20 and 22-23 are directly or indirectly dependent upon Claims 6, 11, 16, and 21, respectively, and are allowable for at least similar reasons.

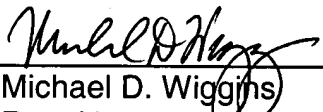
Claims 2, 3, 7, 8, 12, 13, 17, 18, 22, 23, and 29-32 depend either directly or indirectly upon Claims 1, 6, 11, 16, or 21, which are allowable over the prior art. Therefore, Applicant respectfully submits that Claims 2, 3, 7, 8, 12, 13, 17, 18, 22, 23, and 29-32 are allowable for at least similar reasons.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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